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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,403	10/31/2001	Thomas Gharst	1146-PA02	3059

7590

03/26/2004

Butler, Snow, O'Mara, et. al.  
P. O. Box 171443  
Memphis, TN 38187

EXAMINER
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ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
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3724

12

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/001,403

Applicant(s)

GHARST, THOMAS

Examiner

Boyer D. Ashley

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-21 is/are allowed.
- 6) ☒ Claim(s) 1-17 and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3724

## DETAILED ACTION

1. This office action is in response to applicant's amendment filed 12/22/03, wherein claims 1, 5, and 18 were amended.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, the expressions "a scoring path" and "a groove" appear to be double inclusions of the scoring path and groove of claim 1.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-17 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keon et al, U.S. Patent 5,046,392, in view of Nikkel, U.S. Patent 5,158,525.

Keon et al. discloses an insulation carrying, cutting, and scoring device wherein the cutting means cuts a first portion of the insulation by use of a cutting blade and cutting groove. The scoring means scores a second portion of the insulation as the

Art Unit: 3724

same time of that the cutting means cuts the first portion, wherein the scoring means includes a scoring blade and a rubber strip positioned below the scoring blade. The yielding nature of the rubber strip allows the second portion to be cut without cutting the backing layer.

Nikkel shows that the use of scoring blades in combination with grooved paths are equivalent structure known in the art for the purpose of facilitating scoring a top surface of a fibrous material while not cutting the bottom surface. Therefore, because these two scoring tools/methods were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a scoring blade with scoring path groove for the scoring blade and rubber strip.

As to claim 4, the modified device of Keon et al. discloses a cutting means and a scoring means that are spatially fixed. See Figure 4.

As to claims 6, the modified device of Keon et al. discloses a cutting means is spatially fixed relative to the carrying means.

As to claim 7, the modified device of Keon et al. discloses the cutting groove being substantially linear.

As to claim 8, the phrase "... cutting groove is greater than or equal to the width of said insulation" does not serve to distinguish the prior art from the claimed invention because it is in terms of the workpiece.

As to claims 9-10, the modified device of Keon et al. discloses the substantially parallel to the cutting groove and substantially the same length.

Art Unit: 3724

As to claim 11-13, the modified device of Keon et al. discloses the invention substantially as claimed except for the specific distances between the scoring path and the cutting groove. In this case, 1.5 inches, 0 to ten inches, or 0 to 100 inches. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the specific distance or range of distances between the cutting and scoring blades in order to provide the required backing lay without insulation depending upon the specific type job or size of insulation needed, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

As to claims 14-17, Keon et al. discloses the use of rotary/circular cutting and scoring blades. See Figures 3 and 4.

6. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keon et al. in view of Nikkel as applied to claim 1 above and further in view of Dueck et al., U.S. Patent 4,809,921, or Gordon, U.S. Patent 2,598,992.

The modified device of Keon et al. discloses the invention substantially as claimed except for the carrying means being a dolly. However, Dueck and Gordon disclose that it is old and well known in the art to use dollies with dispensing and cutting apparatus for the purpose of facilitating movement of the device of the device into a better dispensing position. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a dolly with the dispensing device of the modified device of Keon et al. in order to facilitate placement of the device as well as to make the device portable. Moreover, it would have been obvious to one

Art Unit: 3724

having ordinary skill in the art at the time the invention was made to use the modified device of Keon et al. with a dolly for the purpose of facilitating placement of the device, because it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art.

As to claim 3, the modified device of Keon et al. discloses a carrying means comprising two handles that also function as feet (18, see Dueck et al.). In the alternative, the modified device of Keon et al. discloses the use of carrying means having a single handle (42, see Gordon) that also functions as a foot for support the device when lowered to the ground. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use two handles, one on each side of side bars (10, Gordon) instead of a single handle in the center for the purpose of providing a more stable support for dispensing when lowered as well as providing an easier mode of movement by allowing the user to use both hands during movement from one location to another, because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

***Allowable Subject Matter***

7. Claims 18-21 appear allowable over the prior art of record.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-17 and 22-25 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3724

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
March 22, 2004